REMARKS

This is a full and timely response to the outstanding final Office Action mailed September 26, 2007. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claim 3 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The Examiner has maintained the rejection of claim 3 under 35 U.S.C. § 112, second paragraph, for inclusion of the term "approximately". As indicated in Applicant's response filed April 26, 2007, the Federal Circuit has acknowledged that relative terms such as "approximately" are ubiquitous in patent claims and therefore not per se improper.

Regarding the Examiner's argument on page 5 of the final Office Action that the phrase "no more than approximately 2 kilobits of graphical data is transmitted per second" is somehow inconsistent with Applicant's specification, Applicant notes that, as acknowledged by the Examiner, Applicant explicitly discloses controlling a data transmission rate such that it "*does not exceed* a predetermined maximum data transfer rate". *Applicant's specification*, page 8, lines 19-21 (emphasis added). Furthermore, Applicant explicitly discloses an example maximum data transfer rate of "*approximately 2 kilobits per second.*" *Applicant's specification*, page 8, lines 22-23 (emphasis added). It therefore follows that Applicant explicitly discloses the claimed transmitting graphical

data to "such that no more than approximately 2 kilobits of graphical data is transmitted per second" in Applicant's specification. Applicant notes that the phrase "does not exceed x" is clearly equivalent to "no more than x."

In view of the above, it is respectfully asserted that the limitations of claim 3 both agree with Applicant's specification and define the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-12, 21-24, and 26 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Laube* (U.S. Pat. No. 4,653,086). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Laube reference. Applicant discusses the Laube reference and Applicant's claims in the following.

A. The Laube Disclosure

Laube discloses a communication terminal that processes both voice and graphical information. *Laube*, Abstract. As described by Laube, the communication terminal 10 includes a telephone set 14, which can be used as a conventional telephone, and a touch sensitive display screen 32, which can be used to generate graphical information to be simultaneously transmitted with voice information over a subscriber line. *Laube*, column 3, lines 19-29; column 4, lines 39-44; and column 5, lines 45-52.

B. Applicant's Claims

As is noted above, Laube fails to teach several of Applicant's claim limitations. Applicant discusses some of those claim limitations in the following.

1. Claims 1-5 and 21-23

Applicant's independent claim 1 provides as follows (emphasis added):

> 1. A method for transmitting graphical data via a communication line, comprising:
>
> generating graphical data representative of a user input;
>
> buffering the graphical data in memory; and
>
> *transmitting portions of the graphical data* over the communication line to a remote device *at a controlled rate that does not exceed a predetermined maximum data transfer rate at which a bandwidth of the communication line would be exceeded.*

Regarding claim 1, Laube does not teach "transmitting portions" of graphical data "at a controlled rate that does not exceed a predetermined maximum data transfer rate at which a bandwidth of the communication line would be exceeded". Applicant notes that column 5, lines 47-52 of the Laube reference, which were relied upon in the Final Office Action, do not teach transmitting any data "at a controlled rate". Instead, that portion of the Laube reference merely states that voice and graphical information are transmitted "within a limited bandwidth." *Laube*, column 5, lines 50-51. Laube's reference to "limited bandwidth" is a reference to the *frequency band* used to transmit the voice and graphical information, not the *rate* at which graphical data is transmitted. We know this because Laube states that a "frequency multiplexer" is used to so transmit the voice and graphical information. *Laube*, column 5, lines 49-51.

Applicant further notes that column 7, lines 1-10 of the Laube reference, which were also relied upon in the Final Office Action, do not teach transmitting any data "at a controlled rate". Instead, that portion of the Laube reference merely states that the frequency multiplexer provides for simultaneous transmission of voice and "redundancy reduced graphical data". Laube does not define what "redundancy reduced graphical data" is and, therefore, it cannot be determined from the reference what Laube is describing. Regardless, it is clear that transmitting "redundancy reduced graphical data" is not a teaching of transmitting data "at a controlled rate".

Regarding the Examiner's argument on page 3 of the Final Office Action that "Transmission using frequency division multiplexing inherently is done at a controlled rate with a predetermined maximum data transfer rate, i.e. bandwidths of the frequency divisions," Applicant disagrees. Specifically, the term "frequency division multiplexing"

denotes dividing a transmission among multiple frequencies, not limiting data transfer rate relative to a predetermined maximum data transfer rate.

Regarding the Examiner's statement on page 3 that "evidence has been provided" that frequency division multiplexing inherently requires transmitting data "at a controlled rate that does not exceed a predetermined maximum data transfer rate", Applicant notes that the Examiner has *not* identified with particularity a specific teaching on pages 594-596 of the "Signals and Systems" book that states that frequency division multiplexing *inherently requires* transmitting data "at a controlled rate that does not exceed a predetermined maximum data transfer rate". Applicant has reviewed the cited pages and finds no such teaching. Applicant therefore requests that the Examiner explicitly identify the line or lines within the cited pages that state that frequency division multiplexing *inherently requires* transmitting data "at a controlled rate that does not exceed a predetermined maximum data transfer rate".

Applicant further notes that just because data transfer rates could be controlled in Laube's frequency division multiplexing scenario, this does not mean that such control is inherent to Laube's disclosure. As described by the Federal Circuit:

> Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *See Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Scaltech Inc. v. Retec/Tetra, L.L.C., 178 F.3d 1378, 51 USPQ2d 1055 (Fed. Cir. 1999), Revising, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998). Furthermore, the Federal Circuit has noted:

> Under the principles of inherency, if the prior art *necessarily functions* in accordance with, or includes, the claimed limitations, it anticipates.

In the present case, Laube's system does not "necessarily function" to control data transfer rate so as not to exceed a predetermined maximum data transfer rate.

2. Claims 6-12 and 21-23

Applicant's independent claim 6 provides as follows (emphasis added):

> 6. A method for transmitting graphical data via a communication line, comprising:
>
> generating graphical data representative of a user input;
>
> identifying discrete data points of the generated graphical data; and
>
> *transmitting only the identified discrete data points over the communication line to a remote device such less than all of the generated graphical data is transmitted so as to not exceed a bandwidth of the communication line.*

Regarding claim 6, Laube does not teach transmitting only "discrete data points over the communication line to a remote device such less than all of the generated graphical data is transmitted so as to not exceed a bandwidth of the communication line". Applicant notes that column 5, lines 47-52 of the Laube reference, which were relied upon in the Final Office Action, do not teach transmitting any such "discrete data

points". Instead, that portion of the Laube reference merely states that voice and graphical information are transmitted "within a limited bandwidth." *Laube*, column 5, lines 50-51. Laube's reference to "limited bandwidth" is a reference to the frequencies used to transmit the voice and graphical information, not the nature of the data that is transmitted. Again, we know this because Laube states that a "frequency multiplexer" is used to so transmit the voice and graphical information. *Laube*, column 5, lines 49-51.

Applicant further notes that column 7, lines 1-10 of the Laube reference, which were also relied upon in the Final Office Action, do not teach transmitting "discrete data points". Instead, that portion of the Laube reference merely states that the frequency multiplexer provides for simultaneous transmission of voice and "redundancy reduced graphical data". As noted above, Laube does not define what "redundancy reduced graphical data" is and, therefore, it cannot be determined from the reference what Laube is describing. Regardless, it is clear that Laube's identification of "redundancy reduced graphical data" is not an actual teaching of "transmitting only . . . discrete data points". A proper rejection under 35 U.S.C. § 102 requires disclosure of *each element* of the claim under consideration.

Regarding the Examiner's argument on page 3 of the Final Office Action that it "naturally" follows that Laube's system transmits a "subset of stored coordinate values" simply by virtue of the fact that Laube mentions "extracted coordinate values" in column 6, Applicant submits that there is absolutely no reason to assume that Laube's system transmits a "subset of stored coordinate values" in view of Laube's disclosure. Simply stated, there is just no support for such an assumption. In columns 6 and 7, Laube

indicates that the coordinate values of a user's pen 50 are represented in an image-dotwise manner on the display screen 32 by evaluating extracted coordinate values. Such a disclosure does not necessarily mean, however, that Laube's system transmits only "identified discrete data points over the communication line to a remote device such less than all of the generated graphical data is transmitted". Indeed, for all the reader knows, each and every data point identified by Laube's system is sent to a recipient. Again, inherency may not be established by mere possibilities.

3. Claims 24 and 26

Applicant's independent claims 24 and 26 provide as follows (emphasis added):

> 24. A computer-readable memory that stores a system for sharing graphical data via a communication line, the system comprising:
>
> means for receiving voice data;
>
> means for generating graphical data representative of a user input entered into a touch-sensitive display; and
>
> means for simultaneously transmitting the voice data and information representative of the generated graphical data via the communication line such that a bandwidth of the communication line is not exceeded, wherein the means for transmitting comprise means for buffering the graphical data and *means for transmitting portions of the graphical data over the communication line at a controlled rate that does not exceed a predetermined maximum data transfer rate.*

26. A computer-readable memory that stores a system for sharing graphical data via a communication line, the system comprising:

means for receiving voice data;

means for generating graphical data representative of a user input entered into a touch-sensitive display; and

means for simultaneously transmitting the voice data and information representative of the generated graphical data via the communication line such that a bandwidth of the communication line is not exceeded, wherein the means for transmitting comprise means for identifying discrete data points of the generated graphical data and *means for transmitting only the identified discrete data points over the communication line such less than all of the generated graphical data is transmitted.*

Beginning with claim 24, Applicant notes that Laube at least does not teach "means for transmitting portions of the graphical data over the communication line at a controlled rate that does not exceed a predetermined maximum data transfer rate" for reasons described above in relation to claim 1. As explained above, Laube's frequency division multiplexing does not inherently require transmitting portions of data at a controlled rate that does not exceed a predetermined maximum.

Turning to claim 26, Applicant notes that Laube at least does not teach "means for transmitting only the identified discrete data points over the communication line such less than all of the generated graphical data is transmitted" for reasons described above in relation to claim 6. As explained above, Laube does not teach transmitting any such "discrete data points". Instead, that portion of the Laube reference merely states that voice and graphical information are transmitted "within a limited bandwidth.

Furthermore, Laube's identification of "redundancy reduced graphical data" is not an actual teaching of "transmitting only . . . discrete data points".

III. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 17-20 and 27

Claims 17-20 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laube* in view of *Lamb* (U.S. Pat. No. 6,791,571). Applicant respectfully traverses this rejection.

1. Claims 17-20

Applicant's independent claim 17 provides as follows (emphasis added):

> 17. A method for transmitting graphical data via a communication line, comprising:
>
> generating graphical data representative of a user input;
>
> identifying a reference data point;
>
> transmitting information that describes the reference data point via the communication line;
>
> *identifying relative coordinates of a further data point that identify the location of the further data point relative to the reference data point*; and
>
> transmitting the coordinates to another device via the communication line.

In the Final Office Action, it is acknowledged that Laube does not teach "identifying relative coordinates of a further data point that identify the location of the further data point relative to the reference data point". In view of that shortcoming of the Laube reference, the Examiner relies upon the Lamb reference, which discloses an "absolute and relative coordinate based format description system." *Lamb*, Abstract.

As a first matter, Applicant notes that Lamb does not disclose a method for identifying relative coordinates of data points in relation to graphical data being generated by user input. Instead, Lamb describes a coordinate based format description for "geometrical objects," such as interactive multimedia, that can be located within an HTML working area. *Lamb*, column 3, lines 18-21 and lines 41-48. In other words, Lamb's format description provides an indication of the locations of multimedia objects in an HTML document. For at least that reason, Lamb does not provide a teaching or suggestion of determining and transmitting relative coordinates of graphical data being input, which is missing from Laube's disclosure.

As a second matter, Applicant notes that because Lamb does not disclose a method for describing graphical data generated by user input and intended for transmission as claimed by Applicant and disclosed by Laube, a person having ordinary skill in the art simply would not think to add Lamb's "coordinate based format description" into Laube's system. Moreover, given the differences in applications described by Laube and Lamb, it is unclear how such addition would be accomplished and what outcome would result.

In view of at least the above, Applicant submits that claim 17 and its dependents are not obvious in view of the Laube and Lamb references.

2. Claim 27

Applicant's independent claim 27 provides as follows (emphasis added):

27. A computer-readable memory that stores a system for sharing graphical data via a communication line, the system comprising:

means for receiving voice data;

means for generating graphical data representative of a user input entered into a touch-sensitive display; and

means for simultaneously transmitting the voice data and information representative of the generated graphical data via the communication line such that a bandwidth of the communication line is not exceeded, wherein the means for transmitting comprise means for identifying a reference data point, means for transmitting information that describes the reference data point via the communication line, *means for identifying coordinates of a further data point that identify the location of the further data point relative to the reference data point*, and means for transmitting the coordinates via the communication line.

Regarding claim 27, Laube and Lamb at least fail to teach or suggest means for identifying a reference data point and "means for identifying coordinates of a further data point that identify the location of the further data point relative to the reference data point" at least for reasons discussed above in relation to claim 17.

B. Rejection of Claims 29-36

Claims 29-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laube* in view of *Torihata, et al.* ("Torihata," U.S. Pat. No. 4,794,634). Applicant respectfully traverses the rejection.

As identified above, Laube does not teach aspects of Applicant's claims. In that Torihata does not remedy the deficiencies of the Laube reference, Applicant respectfully submits that claims 29-36 are allowable over the Laube/Torihata combination for at least the same reasons that claim 29 is allowable over Laube.

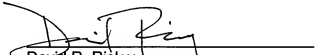
C. Rejection of Claim 37

Claim 37 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Laube* in view of *Torihata* as applied to claim 29, in view of *Kishimoto, et al.* ("Kishimoto," U.S. Pat. No. 4,597,101). Applicant respectfully traverses the rejection.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David R. Risley
Registration No. 39,345